

### **REMARKS**

The Office Action has been carefully reviewed. Claims 1-31 are pending. Claims 14 and 31 have been amended. No new matter has been added. Claims 1-31 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,055,573 to Gardenswartz *et al.* (“Gardenswartz”). See Office Action, page 3. Applicant responds as follows.

#### **I. Rejections Under 35 U.S.C. § 103**

Claims 1-31 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,055,573 to Gardenswartz *et al.* (“Gardenswartz”). See Office Action, page 3. Applicant hereby respectfully traverses this rejection.

##### **A. Gardenswartz Fails to Teach or Suggest Inquiring a Third Party Based on Received Information Related to Consumer Personal Identification Information**

Claim 14 of the present application recites “**inquiring a third party based on the received information related to the consumer personal identification information** whether the consumer has been pre-qualified for a financial instrument, ... and offering the consumer the financial instrument.” In contrast, Gardenswartz recites “[i]t is another object of the present invention to provide a novel method, system, and computer program product for providing advertisers with information relating to consumers' observed offline purchase histories **without divulging to the advertisers the proprietary information of another, such as the consumers' customer identifications (CIDs)**.” See Gardenswartz, column 2, line 66 - column 3, line 4 (emphasis added). As an alternative to disclosing personal identification, Gardenswartz teaches “deliver[ing a] targeted advertisement to consumer's computer based on purchase behavior classification **associated with cookie number** received from consumer's computer.” See Gardenswartz, Figure 9, element 82 (emphasis added). Thus, Gardenswartz fails to teach or suggest the use of information related to the consumer personal identification for inquiring a third party.

The Office asserts that “inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with the financial institution” is disclosed by Gardenswartz's Figure 5, element 504; column 10, lines 16-23; Figure 8 and the description of Figure 8. See Office Action, page 4. Applicants note that the cited portions do not disclose “inquiring a **third party** based on the received information related to the consumer

**personal identification information.**” In fact, Gardenswartz states “[a]s demonstrated by the process shown in Fig. 8, advertisers who maintain servers other than the registration server 14 may be provided with targeted ad profiles **without being provided with** any of the data stored in the purchase history database 8, including **CIDs, the consumers’ identities**, and their observed purchase history.” Gardenswartz column 13, lines 40-45 (emphasis added). The other relied upon citations similarly fail to teach or suggest **“inquiring a third party based on the received information related to the consumer personal identification information** whether the consumer has been pre-qualified for a financial instrument, ... and offering the consumer the financial instrument.”

The Office admits that Gardenswartz “does not explicitly teach pre-qualifying a consumer for a financial instrument by checking his credit rating.” *See* Office Action, page 4. The Office asserts that certain modifications (addressed in section B below) would have been obvious. Applicant respectfully submits however, that even with these proposed modifications, Gardenswartz fails to teach or suggest **“inquiring a third party based on the received information related to the consumer personal identification information** whether the consumer has been pre-qualified for a financial instrument, ... and offering the consumer the financial instrument.”

As stated in MPEP § 2143.03, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382 (CCPA 1970).

**B. Modifying Gardenswartz to Offer a Product Based on Pre-Qualification Would Render Gardenswartz Unsatisfactory For Its Intended Purpose**

Claim 14 of the present application recites **“offering the consumer the financial instrument** for which he or she is pre-qualified, **if confirmation is received from the third party that the consumer is pre-qualified for a financial instrument.**” The Office admits that Gardenswartz “does not explicitly teach pre-qualifying a consumer for a financial instrument by checking his credit rating.” *See* Office Action, page 4. The Office asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gardenswartz’s system to include the financial instrument product and credit rating checking to offer consumer with different products.” *See* Office Action, page 5. Applicant respectfully

disagrees.

Gardenswartz states “one object of this invention is to provide a novel method, system, and computer program product for delivering targeted advertisements to a consumer based on his or her offline purchase history.” *See* Gardenswartz, column 2, lines 58-61. Applicant notes that other listed objects of invention are similarly associated with a consumer’s offline purchase history. *See* Gardenswartz, column 2, lines 62 - column 3, line 4. *See also* Figures 5, 6, 8, 9, and 11. Gardenswartz’s offering of targeted advertisements is based upon offline purchase history, not “if confirmation is received from the third party that the consumer is pre-qualified for a financial instrument,” as recited by claim 14. In fact, Gardenswartz is directed towards “Communicating With a Computer Based On An Updated Purchase Behavior Classification of a Particular Consumer.” *See* Gardenswartz Title. Modifying Gardenswartz as proposed by the Office would require Gardenswartz to offer a consumer a financial instrument “if confirmation is received from the third party that the consumer is pre-qualified for a financial instrument,” not based upon the consumer’s offline purchase history. Applicant respectfully submits that modifying Gardenswartz as proposed by the Office, would render Gardenswartz unsatisfactory for its intended purpose.

As stated in MPEP § 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Furthermore, Gardenswartz teaches away from making the proposed modifications. To modify Gardenswartz as proposed would require Gardenswartz to inquire of a third party “based on the received information related to personal identification information.” As discussed above Gardenswartz states “[i]t is another object of the present invention to provide a novel method, system, and computer program product for providing advertisers with information relating to consumers’ observed offline purchase histories **without divulging to the advertisers the proprietary information of another, such as the consumers’ customer identifications (CIDs).**” *See* Gardenswartz, column 2, line 66 - column 3, line 4 (emphasis added).

Gardenswartz, as discussed above in section A, states in numerous places that it is undesirable to disclose customer identifications to third parties. *See* Gardenswartz, column 2, line 66 - column 3, line 4; and Gardenswartz column 13, lines 40-45. Thus, Gardenswartz teaches away from a proposed modification which would require disclosure of personal identification to third parties. For at least these reasons the Office's proposed modifications are improper.

**C. Gardenswartz Fails to Teach or Suggest the Consumer is a Customer of a Financial Institution or An Entity Associated with the Financial Institution**

Claim 14 of the present application recites "receiving information related to personal identification information associated with a consumer who is a **customer of a financial institution or an entity associated with the financial institution.**" Gardenswartz fails to teach or suggest a financial institution or an entity associated with a financial institution. Gardenswartz is directed towards tracking purchase histories of consumers at stores. *See* Figure 1, elements 2, 4, 6, and 8; Figure 2(a); Figure 2(b), element 36. Gardenswartz states "purchase history database 8 stores purchase data received from the stores 2, 4, 6." Gardenswartz column 6, lines 10-11. Gardenswartz further states "the advertisements might be for product offers that are only good at stores, such as stores 2, 4, 6, that provide purchase history information to the purchase history database 8." Gardenswartz, column 14, lines 26-29. Gardenswartz is directed towards advertisements based on purchase histories at retail stores. Gardenswartz fails to teach or suggest "receiving information related to personal identification information associated with a consumer who is a **customer of a financial institution or an entity associated with the financial institution,**" as recited in claim 14.

The Office admits that Gardenswartz fails to disclose a financial instrument and credit checking. *See* Office Action, page 4. However, the Office fails to address "receiving information related to personal identification information associated with a consumer who is a **customer of a financial institution or an entity associated with the financial institution,**" as recited in claim 14. Applicant respectfully submits that an assertion that it is possible to modify Gardenswartz to incorporate financial products and credit checking does not address the above limitation.

Furthermore, Applicant notes that the citations by the Office for this element (i.e., Figure 5, elements 500, 502; column 10, lines 3-9, Figures 6, 7 and corresponding descriptions) fail to teach or suggest "receiving information related to personal identification information associated

with a consumer who is a **customer of a financial institution or an entity associated with the financial institution,**” as recited in claim 14. For at least these reasons, independent claim 14 is patentable over Gardenswartz.

Regarding claims 1, 12 and 31, these claims recite subject matter related to claim 14. Thus, the arguments set forth above with respect to claim 14 are equally applicable to claims 1, 12 and 31. Accordingly, is it respectfully submitted that claims 1, 12 and 31 are allowable over Gardenswartz for the same reasons as set forth above with respect to claim 14.

Regarding claims 2-11, 13, and 15-30, these claims are dependent upon independent claims 1, 12, and 14 respectively. Thus, since independent claims 1, 12, and 14 should be allowable as discussed above, claims 2-11, 13, and 15-30 should also be allowable at least by virtue of their dependency on independent claims 1, 12, and 14.

**CONCLUSION**

Applicant respectfully submits that claims 1-31 are in condition for allowance and request allowance of the same.

This Amendment and Response has been filed within three months of the mailing date of the Office Action and it is believed that no fees are due for this filing. If any fees are determined to be due, the Commissioner is hereby authorized to deduct such fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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